

REMARKS

By the present amendment, Applicant has canceled Claims 1-11 and added Claims 12-19, which remain pending in the present application. Claim 12 is the sole independent claim.

In the Office Action dated October 31, 2005, the drawings were objected to under 37 CFR 1.83(a) and Claims 1-11 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner also rejected Claims 1-11 under 35 U.S.C. § 103(a) as being unpatentable over Hagen et al. (U.S. Patent No. 6,491,315) in view of Duerkob. (U.S. Patent No. 4,954,808), or further in view of Mureller (U.S. Patent No. 6,179,842), Cipolla (U.S. Patent No. 6,769,704), or Osborne, Sr. (U.S. Patent No. 4,965,704).

The Examiner objected to the drawings as failing to show the ends of the bar as “extending outwardly and rearwardly” as recited in Claim 6. Applicant has canceled the instant claim, which should serve to render this particular ground of objection moot. Note that new Claim 16, which corresponds to canceled Claim 6, characterize the ends of the bar in question as being angled and extend rearwardly of the front wall, which is adequately supported by the original drawings.

Also, new Claims 12-19 are devoid of the originally recited term “standard” which was criticized of record by the Examiner as being indefinite. Applicant respectfully submits that the newly introduced claims are in compliance with the specific requirements of 35 U.S.C. § 112, second paragraph.

The cancellation of original Claims 1-11 and the introduction of new Claims 12-19 by the present amendment should serve to obviate the prior art grounds of rejection of record. Applicant will advance arguments hereinbelow to illustrate the manner in which the invention defined by the newly introduced claims is patentably distinguishable from the cited and applied prior art. Reconsideration of the present application is respectfully requested.

Applicant has introduced the new claims to more particularly define the subject matter in question. New independent Claim 12 is directed towards the embodiments of Applicant’s invention shown in Figs. 1-4. Claim 12 sets forth a turn signal step bar for a vehicle that includes, in part, an elongated bar, a step surface member and a tubular tongue member. The tubular bar is defined as having a generally rectangular cross section and including a top wall, a bottom wall, a front wall, a back wall, and opposite ends, wherein the front wall has a width greater than that of the top wall. The step surface member is characterized as being attached to the top wall of the tubular bar. The tubular tongue member is described as being adapted for attachment to a hitch receiver of the vehicle, and as

being secured centrally and perpendicularly to back wall of said tubular bar. The claimed turn signal step bar further includes left and right signal lamps respectively disposed proximate the opposite ends of the tubular bar and running lamps disposed between the signal lamps. A wiring is defined as connecting running lamps and signal lamps to a trailer plug, which is claimed as being adapted for electrically connecting the running lamps to a brake light circuitry of the vehicle and for electrically connecting the signal lamps to a turn signal circuitry of the vehicle. New dependent Claims 13 and 14 corresponds substantially to original Claims 2 and 3, respectively. New dependent Claims 15 and 16 correspond substantially to original Claims 5 and 6, respectively. New Claim 17 sets forth that the ends of the bar have plastic endcaps disposed therein, which feature is supported at page 5, lines 14-17, of the specification. New dependent Claims 18 and 19 correspond to original Claims 10 and 11. No new matter is involved by the amendatory subject matter of the newly added claims since the same find clear support in the written description and drawings contained in the original disclosure.

Applicant contends that the Hagen et al. reference taken in combination with Duerkob, or any of the other ancillary references relied upon of records, fail to reasonably suggest a turn signal step bar having the combination of structural and functional features as defined by the present claims.

The patent to Hagen et al., which is acknowledged by Applicant, discloses a brake warning and step assembly that is inserted into a trailer hitch connection of a vehicle. This reference assembly

includes an elongated tubular housing unit with brake warning lights mounted within the housing unit. Upon electrical connection of the reference assembly to the vehicle's wiring harness, the warning lights of Hagen et al. are illuminated when the brakes are applied to provide additional warning that a stop of the vehicle is being made. While the reference teaches that the tubular housing unit has a rectangular cross section, it should be noted that the top wall of Hagen's housing unit is shown to have a width greater than the width of the front wall. In contrast, the front wall of Applicant's tubular bar is claimed as having a width greater than that of the top wall to provide a greater surface area of illumination. In further contrast to Applicant's invention and more importantly, there appears no mention or suggestion in Hagen et al. of left and right turn signal lamps respectively disposed proximate the opposite ends of the tubular step bar and electrically connected the vehicle's turn signal circuitry as set forth by the present claims.

The Examiner asserts that it would be obvious to one of ordinary skill in the art to modify the step assembly of Hagen et al. by connecting at least the right and left lamps of this primary reference to the turn signal circuit of a vehicle in light of the teachings afforded by the secondary reference to Duerkob. However, the patent to Duerkob describes a lighted turn and stop signal unit for eye level use mounted on the inside rear shelf of an automobile. Duerkob further teaches his signal unit is light weight and made plastic materials, which would render it unsuitable as a step for mounting to a trailer hitch. Thus, eye level, interior mounted signal unit of Duerkob is so structurally and functionally

unrelated to the trailer hitch step taught by Hagen et al. that any assumption that one of ordinary skill in the art would likely be motivated to combine these references in the manner suggested by the Examiner is completely unfounded.

Applicant notes that obviousness cannot be shown by combining the teachings of the prior art unless there is some teaching or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984); *In re Geiger*, 815 F.2d at 688, 2 USPQ2d at 1278 (Fed. Cir. 1987). Further, the Federal Circuit in *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed.Cir. 1999) deprecated rejections based upon "a hindsight-based obviousness analysis" and emphasized that what is required is a "rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." The Court said that "the showing must be clear and particular" and that broad conclusory statements regarding the teaching of multiple references and "a mere discussion of the ways that the multiple prior art references can be combined to read on the claimed invention" is inadequate. Absent an explicit suggestion or teaching of the combination in the prior art references, there must be "specific...findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis".

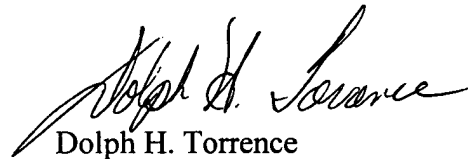
Applicant contends that one skilled in the art would not be motivated or guided by the prior art to combine these references in the manner suggested by the Examiner since the eye level, interior mounted, light-weight signal unit taught by the secondary reference to Duerkob is so structurally and functionally unrelated to the trailer hitch step of primary reference to Hagen et al. as to make such a combination highly impractical. Moreover, Applicant further contends that the specific teachings afforded by the ancillary references to Muller, Cippolla and Osborne, Sr. fail to provide any guidance for combining the primary and secondary references together and fail to supplement the above noted deficiency of the primary reference to Hagen et al. Thus, one of ordinary skill in the art without the benefit of Applicant's own disclosure would not be capable of arriving at the presently claimed invention by combining the references in the manner suggested by the Examiner since none of references cited or applied of record realistically suggests the essential combination of features that forms the basis of the instant claims. For at least these reasons, Applicant respectfully submits that new independent Claim 12 and corresponding new dependent Claims 13-19 are allowable over the prior art of record.

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Art Unit : 3618

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For the foregoing reasons, Applicant respectfully submits that the present application is in condition for allowance. If such is not the case, the Examiner is requested to kindly contact the undersigned in an effort to satisfactorily conclude the prosecution of this application.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read 'Dolph H. Torrence', written in black ink.

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DHT/rwg

Attachments: Petition for Extension of Time
Check in the amount of \$60.00